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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
AHMED, AFFAF				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,208

Applicant(s)

MODI, MANAW

Examiner

AFAF AHMED

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11,13-28,30 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11,13-28,30 and 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 06/08/2009.
2. Claims 1, 11, 13, 15, 16, 21, 24, 25, 30, 32, 34, 35, and 38-40 have been amended.
3. Claims 41-43 have been added.
4. Claims 8, 10, 12, 27, 29, 31 have been canceled.
5. Claims 1-7, 9, 11, 13-26, 28, 30 and 32-43 are currently pending and have been examined.

Response to Applicant's Arguments

6. Applicant's amendments and arguments filed on 06/08/2009 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.
7. With regard to claims 21, 39 and 40 rejection under 35 USC § 101, Applicant has amended the claims. Therefore the rejection is withdrawn.
8. With regard to claim 21 rejection under 35 USC § 112 second paragraph rejection, Applicant has amended the claims. Therefore the rejection is withdrawn.
9. Applicant's argument with regard to claims 1, 21 and 38-40 are considered, but are moot based on the new ground of rejections.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 21 and 38- 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
12. Claims 1, 21 and 38-40 recite the limitations of:

- *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive.*

The specification teaches " Financial account provider 110-1 may leverage one or more stored rules to determine the type of incentive to apply to the primary financial account based on the transactions performed by user 135 during the monitored transaction time period. The rules are configurable by financial account provider 110-1 such that the incentives and conditions for receiving different incentives may change while user 135 is a holder of the primary financial account. For illustration purposes, Table 3 shows a listing of exemplary rules and corresponding incentives that may be applied by financial account provider 110-1 during the incentive process (paragraph 46). As shown in Table 3, financial account provider 110-1 may apply different incentives to the primary financial account based on the rules/conditions associated with the monitored transactions. The first incentive may include incentives that are more attractive than the other incentives offered by financial account provider 110-1. The term "more attractive" refers to conditions that are more beneficial to user 135 in terms of the primary financial account than less attractive incentives (paragraph 47).

The specification does not teach "*configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive*".

Furthermore, the specification teaches "Alternatively, the second incentive may include adding a certain amount to the credit limit if the subset of transactions includes a total purchase amount above a predetermined threshold number. The second incentive may also include incentives that are less attractive than the first incentive, but more attractive than certain remaining incentives (i.e., the third incentive) (paragraph 47).

The specification does not teach *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive*".

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1, 21 and 38- 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claims 1, 21 and 38-40 recite the limitations of:

- *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive.* It is unclear what Applicant is referring to by *configuring the first financial account to provide a first incentive*, and *configuring the first financial account to provide a second incentives*. An account does not provide an incentive, a provider of the account is the one that provides the incentive. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 1-3, 7-11, 15-21, 26-30, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Blagg et al, US Pub No: 2003/0171992 A1.

Claims 1, 21, 38 and 39:

Todd discloses:

- *monitoring transactions performed using the first financial accounts over a predetermined transaction monitoring period; determining whether the monitored transactions meet at least one predetermined condition; and applying an incentive to the first financial account based on the predetermined condition (see at least paragraphs 45 and 73);*
- *applying an incentive to the first financial account based on the predetermined condition and determine by the computer whether to apply the first incentive or the second incentive (see at least paragraphs 24-25);*

Todd does not specifically disclose:

- *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive;*

Blagg however, discloses in at least claims 1-5, 10 and 17 a method for processing rewards by identifying a reward type and providing an earning rule that is associated with the reward type. The earning rule indicates that the reward of the reward type is earned at a first rate when an activity is performed in relation to an account group (first account), and a second rate when an activity is performed in relation to an individual account (second account).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Todd's system for rewarding customers of financial providers the ability to include providing different reward types based on the activity of different accounts of the user as taught by Blagg, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results (encouraging usage of one account type over another) of the combination were predictable.

Claims 2 and 22:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses:

- *collecting, by the first financial account provider, transaction information associated with each of the transactions from at least one of: the user, a merchant*

associated with a transaction with the user, a server system that collects the transaction information, and the second financial account provider (see at least paragraph 48);

Claim 3:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses:

- *configuring the first financial account based on input received from the user (see at least paragraph 31);*

Claims 7, 9, 20, 26 and 28:

Todd/ Blagg disclose the limitations as shown above.

Todd discloses:

- *monitoring transactions information for each account (see at least paragraphs 17 and 19 and paragraph 62);*

Claims 8,10,11, 27, 29, 30 and 37:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses

- *applying variety of incentives based on different category of transactions (see at least paragraphs 25 - 27);*

Claims 15 and 34:

Todd/ Blagg disclose the limitations as shown above.

Todd discloses:

- *wherein the incentive includes at least one of adjusting an interest rate for the first financial account, adjusting a credit limit for the first financial account, adjusting an account fee associated with the first financial account, and adding reward points to accumulating reward point total associated with the first financial account (see at least paragraphs 74-79);*

Claims 16 and 35:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses:

- *wherein the incentive is more attractive to the user when more of the transactions are associated with the first financial account as opposed to the second financial account (see at least paragraphs 3 and 12);*

Claims 17, 18, 36 and 37:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses:

- *providing an incentive report to the user based on the applied incentive;*
- *wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined ;*

See at least paragraphs 45-46, 48, 53 and 73;

Claim 19:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses:

- *ranking the transaction based on a transaction parameter associated with each transaction; identifying a set of transactions each have a transaction parameter that meets or exceeds a predetermined transaction parameter threshold and determining whether the set of transactions meet the at least one predetermined condition (see at least paragraph 25);*

19. Claims 4, 5, 6, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view Blagg et al, US Pub No: 2003/0171992 A1 in view of Johnson et al, US Pub No: 2005/0021457 A1.

Claims 4, 5, 6, 23, 24 and 25:

Todd/ Blagg disclose the limitations as shown above.

The combination of Todd/ Blagg does not specifically disclose, but Johnson however discloses:

- *receiving a forecast goal and determining if the forecast goal is met and applying an incentive to the first account when the forecast goal is met (see at least see the abstract and paragraph 10);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Todd's/ Blagg's transferring transactions and rewarding customers of financial

services providers with Johnson's system and method of financial account up-front incentives management with the motivation of tracking incentives that will encourage or reward a specific customer behavior with respect to a specific financial account.

20. Claims 14 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 Blagg et al, US Pub No: 2003/0171992 A1 in view of Watson, US pat No: 5,991,750.

Claims 14 and 33:

Todd/ Blagg disclose the limitations as shown above.

Todd does not specifically disclose, but Watson however discloses:

- *wherein the user gives authorization to transfer transactions* (see at least column 3, lines 32 -54);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Todd's/Blagg's system for rewarding customers of financial providers the ability to pre-authorize of individual account transaction as taught by Watson's since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results (minimizing fraud and abuse in the purchasing of goods and services) of the combination were predictable.

21. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over of Johnson et al, US Pub No: 2005/0021457 A1 in view of Todd, US Pub No: 2003/0061093 in view Blagg et al, US Pub No: 2003/0171992 A1

Claim 40:

Johnson discloses:

- *receiving a forecast goal from the user reflecting an estimated transaction amount the user intends to perform using the first financial account over a future transaction monitoring period;*
- *determining whether the transactions includes purchase amounts associated with the first financial account that collectively meet the forecast goal; applying an incentive to the first financial account when the forecast goal is met; and*

See at least the abstract, paragraphs 10-12;

Johnson does not specifically disclose, but Todd however discloses:

- *providing an incentive report to the user based on the applied incentive, wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined condition (see at least paragraphs 45-46, 48, 53 and 73);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Johnson's system and method of financial account up-front incentives management the ability to reward customers as taught by Todd's since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results (encourage or reward a specific customer behavior with respect to a specific financial account) of the combination were predictable.

The combination of Johnson/ Todd does not specifically discloses:

- *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive;*

Blagg however, discloses in at least claims 1-5, 10 and 17 a method for processing rewards by identifying a reward type and providing an earning rule that is associated with the reward type. The earning rule indicates that the reward of the reward type is earned at a first rate when an activity is performed in relation to an account group (first account), and a second rate when an activity is performed in relation to an individual account (second account).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Todd's system for rewarding customers of financial providers the ability to include providing different reward types based on the activity of different accounts of the user as taught by Blagg, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results (encouraging usage of one account type over another) of the combination were predictable.

22. Claims 13, 32, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Blagg et al, US Pub No: 2003/0171992 A1 in view of Walker et al, US Pat No: 5,949,044.

Claims 13 and 32:

Todd/ Blagg disclose the limitations as shown above.

Todd does not specifically disclose, but Walker however discloses:

- *providing a payment for the second financial account transactions from the first financial account provider to the second financial account provider; and adding a total transaction amount associated with the second financial account transactions to a balance associated with the first financial account (see at least abstract);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Todd's/Blagg's system for rewarding customers of financial providers the ability to include transferring payment between credit cards accounts as taught by Walker, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results (increasing revenue to the primary financial institution and encouraging or rewarding a specific customer behavior with respect to a specific financial account) of the combination were predictable.

Claims 41-43:

Todd/ Blagg disclose the limitations as shown above.

Todd further discloses:

- *determining the computer system whether any transactions that meet the predetermined condition are associated with the second financial account (see at least paragraph 69);*

Todd does not specifically disclose, but Walker, however, discloses:

- *transferring transaction amount between credit cards accounts (see at least column 9, lines 38-62);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Todd's/Blagg's system for rewarding customers of financial providers the ability to include transferring payment between credit cards accounts as taught by Walker, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results (increasing revenue to

the primary financial institution and encouraging or rewarding a specific customer behavior with respect to a specific financial account) of the combination were predictable.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX Months from the mailing date of this final.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamper can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/

Primary Examiner, Art Unit 3622